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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/250,340	02/16/1999	YIK HEI SIA	212/656	1943

23371 7590 01/23/2009
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SUITE 200
MISSION VIEJO, CA 92691

EXAMINER	
KAZIMI, HANI M	
ART UNIT	PAPER NUMBER
3691	

MAIL DATE	DELIVERY MODE
01/23/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/250,340	SIA, YIK HEI	
	Examiner	Art Unit	
	Hani Kazimi	3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 May 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,7-21,23-32,35 and 37-53* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5, 7-21, 23-32, 35, and 37-53* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This communication is in response to Applicant's amendment filed on May 12, 2008. Claims 1-5, 7-21, 23-32, 35, and 37-53 are pending in the application.

Response to Applicant's Amendment

2. Applicants' amendments filed on May 12, 2008 have been fully considered, and discussed in the next section below or within the following rejections under 35 U.S.C. § 102. Applicants' request for allowance is respectfully denied.

Response to Applicants' Amendment

3. The Examiner acknowledges Applicant's response in the remarks filed on May 12, 2008, and therefore withdraws the pervious office action's objection to the specification and the rejection under 35 U.S.C. § 112, first paragraph. The remaining rejections are as stated below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1-5, 7-21, 23-32, 35 and 37-53 are rejected under 35 U.S.C. 103(a) as being obvious over Zampese (U.S. Patent No. 6,014,650) in view of Thomson Components Mostek, "Development Support For Smart Card ICS", September 25, 1987 hereinafter "Thomson".

Claims 1-5, 7-21, 23-32, 35 and 37-53, Zampese discloses a method and a corresponding system for establishing secure connections between a provider and a customer as discussed in the previous office. Further:

Zampese fails to teach that a failure to match the subsequent three access codes renders said accessing station being denied permission to proceed with carrying out said transaction or connection.

Thomson teaches the provision of secret codes against unauthorized users for files protection systems. Thomson states, "Files can be independently protected against unauthorized reading or writing by secret codes or completely looked out from further access, either reading or writing. - Provisions for 7 active secret codes and 2 substitute

codes. - Three modes, user definable, for secret code verification. Three consecutive false code presentations and the card is "locked".”

It would have been obvious to one of ordinary skill in the art at the time the Applicant’s invention was made to modify the teachings of Zampese to include the feature of “a failure to match the subsequent three access codes renders said accessing station being denied permission to proceed with carrying out said transaction or connection” because, it provides a more secure system by preventing unauthorized purchases and fraud (See Zampese, column 2, lines 45-48).

Response to Arguments

5. Applicant's arguments with respect to claims 1-5, 7-21, 23-32, 35 and 37-53 filed on May 12, 2008 have been fully considered but are not persuasive.

Applicant argues in substance that Thomson merely locks out the card, with no mention of first having obtained additional codes. Additionally, neither Zampese nor Thomson provide for any cure to a mismatched code entry. Provision of additional access codes upon an initial mismatch of access codes is clearly contrary to both Zampese and Thomson, and non-obvious over both. Thomson does not provide any limitation missing from Zampese, and thus the claimed invention is not met by the proposed combination.

If Thomson is prior art, it is not apparently analogous. There is no reason that an artisan seeking solutions in code based access would look to the field of development tools for integrated circuits for any solution.

Finally, Thomson is not prior art. The Office Action presents Thomson as prior art, but the reference includes insufficient indication that it was available to the public prior to the invention of the applicant. A press release of 1987 collated into a database made available to the public in 1999 might constitute a publication in 1999, if it is truly available to the public.

In Response to the above arguments;

The Examiner did not rely on Thomson to teach the step of obtaining additional codes, Zampese is reiled upon for this feature. Thomson was only introduced to teach that a failure to match the subsequent three access codes renders said accessing station being denied permission to proceed with carrying out said transaction or connection. Thomson clearly discloses this feature. Thomson states, “Files can be independently protected against unauthorized reading or writing by secret codes or completely looked out from further access, either reading or writing. - Provisions for 7 active secret codes and 2 substitute codes. - *Three modes, user definable, for secret code verification. Three consecutive false code presentations and the card is "locked".”* Thomson locks the card after three consecutive false presentations.

In response to Applicant's argument that Thomson is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker,* 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this particular case, The Thomson reference is reasonably pertinent to the particular problem with which the applicant was concerned, which is protecting files from unauthorized users by using secret codes and using the same verification process. The Thomson reference was relied upon only to teach this feature. Furthermore; The claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

It is noted that KSR forecloses the argument that a **specific** teaching, suggestion, or motivation is required to support a finding of obviousness. Under KSR, a claim would have been obvious if the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art at the time of the invention. Furthermore, under KSR, a claim would have been obvious if a particular known technique was recognized as part of the ordinary capabilities of one skilled in the art. One of ordinary skill in the art would have been capable of applying the teachings of

Thomson into the disclosure of Zampese and the results would have been predictable to one of ordinary skill in the art.

In response to Applicant's argument that the Office Action presents Thomson as prior art,but the reference includes insufficient indication that it was available to the public prior to the invention of the Applicant. Dialog is a search engine that stores various articles, publications and news releases, and has been available to the public since 1970's. News releases are publicly available documents. The copy right date of 1999 is an indication of an update of file 160 "The Gale Group". For more information on Dialog search engines, please visit Dialog Website at www.dialog.com .

The invention is broadly claimed, and the cited reference meets the scope of the claimed limitations.

Conclusion

6. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no

event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (571) 272-6745. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).

/Hani M. Kazimi/

Primary Examiner, Art Unit 3691